

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

Applicant: Robert MARTUZA *et al*

Title: REPLICATION-COMPETENT HERPES SIMPLEX VIRUS  
MEDIATES DESTRUCTION OF NEOPLASTIC CELLS

Appl. No.: 10/748,233

Filing Date: 12/31/2003

Examiner: Wu Cheng Winston SHEN

Art Unit: 1632

Confirmation 7116

Number:

**TERMINAL DISCLAIMER**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Your Petitioner, Georgetown University, having its principal place of business at 37<sup>th</sup> & O Streets, NW, Washington, D.C. 20057, represents that it is the owner of the entire right, title, and interest in and to U.S. Patent Application Serial No. 10/748,233, filed on December 31, 2003, which is a divisional of U.S. Patent Application No. 09/625,509 (now Patent No. 6,699,468), filed on July 25, 2000, which is a divisional of U.S. Patent Application No. 09/004,511 (now Patent No. 6,139,834), filed on January 8, 1998, which is a continuation of U.S. Patent Application No. 08/478,800 (now abandoned), filed on June 7, 1995, which is a continuation of U.S. Patent Application No. 08/264,581 (now Patent No. 5,585,096), filed on June 23, 1994, by virtue of an Assignment filed and recorded on May 1, 1996, on Reel/Frame 7921/0475, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A. Further, your Petitioner represents that it is the owner of U.S. Patent

Application No. 10/788,410, filed on March 1, 2004, which is a divisional of U.S. Patent Application Serial No. 09/625,509 (now Patent No. 6,699,468), filed on July 25, 2000, which is a divisional of U.S. Patent Application No. 09/004,511 (now Patent No. 6,139,834), filed on January 8, 1998, which is a continuation of U.S. Patent Application No. 08/478,800 (now abandoned), filed on June 7, 1995, which is a continuation of U.S. Patent Application No. 08/264,581 (now Patent No. 5,585,096), filed on June 23, 1994, by virtue of an Assignment filed and recorded on May 1, 1996, on Reel/Frame 7921/0475, in the United States Patent and Trademark Office, a copy of which is attached hereto as APPENDIX A.

Your Petitioner, Georgetown University, hereby disclaims the terminal part of the term of any patent granted on U.S. Patent Application No. 10/748,233 which would extend beyond the full statutory term, as shortened by any terminal disclaimer, of any patent granted on U.S. Patent Application No. 10/788,410, and hereby agrees that any patent so granted on U.S. Patent Application No. 10/748,233 shall be enforceable only for and during such period that the legal title to any patent granted on U.S. Patent Application No. 10/788,410 shall be the same as the legal title to any patent granted on U.S. Patent Application No. 10/748,233, this agreement to run with any patent granted on U.S. Patent Application No. 10/748,233 and to be binding upon the grantee, its successors or assigns.

In making the above disclaimer, Petitioner does not disclaim any terminal part of any patent granted on U.S. Patent Application No. 10/748,233, prior to the full statutory term of any patent granted on U.S. Patent Application No. 10/788,410 as defined in 35 U.S.C. §§154-156 and 173, in the event that any patent granted on U.S. Patent Application No. 10/788,410 expires for failure to pay a maintenance fee, is held unenforceable or is found invalid in a final judgment by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a), has all claims canceled by a reexamination certificate or as a result of an interference proceeding, or is otherwise not deemed to provide the rights conveyed by 35 USC §154, prior to the full statutory term of any patent granted on U.S. Patent Application No. 10/788,410 as defined in 35 USC §§154-156 and 173, except for the separation of legal title

stated above. Further, Petitioner does not disclaim any terminal part of a patent granted on U.S. Patent Application No. 10/748,233 that would extend beyond the present termination of any patent granted on U.S. Patent Application No. 10/788,410, in the event that such present term is extended by virtue of compliance with the conditions for term extension of any present or future patent term extension provisions of the patent law, including but not limited to 35 U.S.C. §§155, 155A or 156, and without waiving Petitioner's right to extend the term of a patent granted on U.S. Patent Application No. 10/748,233 to the extent provided by law.

The undersigned, being the Attorney of Record for U.S. Patent Application No. 10/748,233, and duly authorized to act on behalf of Petitioner, certifies that he has reviewed the Assignments attached as APPENDIX A, and to the best of his knowledge and belief, legal title to U.S. Patent Application No. 10/748,233 and any patent granted on U.S. Patent Application No. 10/788,410 rests with Petitioners, Georgetown University. The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-identified application or any patent issuing therefrom.

Respectfully submitted,

Date 6 July 2007

By S. A. Bent

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(A)



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Washington, D.C. 20231

JULY 25, 1996

PTAS

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UNITED STATES PATENT AND TRADEMARK OFFICE  
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THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

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BRIEF: CORRECTED ASSIGNMENT TO CORRECT AN ASSIGNEE ON A DOCUMENT PREVIOUSLY RECORDED ON REEL 7672 FRAME 0367

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DOC DATE: 06/21/1995

ASSIGNOR:

RABKIN, SAMUEL D.

DOC DATE: 06/21/1995

ASSIGNOR:

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DOC DATE: 06/26/1995

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WASHINGTON, D.C. 20057

SERIAL NUMBER: 08264581

PATENT NUMBER:

FILING DATE: 06/23/1994  
ISSUE DATE:

EXHIBIT A

SEDLEY PYNE, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

# ASSIGNMENT - WORLDWIDE

For good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, each undersigned inventor has sold and assigned, and by these presents hereby sells and assigns, unto

Georgetown University  
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Washington, D.C. 20057

its successors and assigns, the entire right, title and interest, so far as concerns the United States and the Territories and Possessions thereof and all foreign countries in and to the invention in

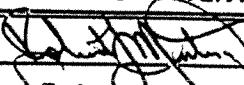
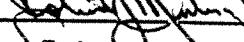
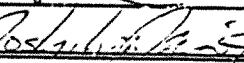
## REPLICATION-COMPETENT HERPES SIMPLEX VIRUS MEDIATES DESTRUCTION OF NEOPLASTIC CELLS

as set forth in his United States Patent Application

— executed concurrently herewith  
— executed on \_\_\_\_\_  
XX Serial No. 08/264,561 filed June 23, 1994

said application for United States Letters Patent, including all divisional, renewal, substitute, continuation and Convention applications based in whole or in part upon said inventions or upon said applications, and any and all Letters Patent and reissues and extensions of Letters Patent granted for said inventions or upon said applications and every priority right that is or may be predicated upon or arise from said inventions, said applications, and said Letters Patent; said Assignee being hereby authorized to file patent applications in any or all countries on any or all said inventions in the name of the undersigned or in the name of said Assignee or otherwise as said Assignee may deem advisable, under the International Convention or otherwise; the Commissioner of Patents and Trademarks of the United States of America being hereby authorized to issue or transfer all said Letters Patent to said Assignee in accordance herewith; this assignment being under covenant, not only that full power to make the same is had by the undersigned, but also that such assigned right is not encumbered by any grant, license, or other right theretofore given, and that the undersigned will do all acts reasonably serving to ensure that the said inventions, patent applications and Letters Patent shall be held and enjoyed by said Assignee as fully and entirely as the same could have been held and enjoyed by the undersigned if this assignment had not been made, and particularly to execute and deliver to said Assignee all lawful documents including petitions, specifications, oaths, assignments, invention disclaimers, and lawful affidavits in form and substance which may be requested by said Assignee, to furnish said Assignee with all facts relating to said inventions or the history thereof and any and all documents, photographs, models, samples or other physical exhibits which may be of said inventions, and to testify in any proceedings relating to said inventions, patent applications and Letters Patent.

The undersigned hereby grant the firm of FOLEY & LARDNER the power to insert in this Assignment any further identification which may be necessary or desirable to comply with the rules of the U.S. Patent and Trademark Office for recordation of this Assignment.

NAMES AND SIGNATURES OF INVENTORS		
Name: Robert L. MARTUZA	Signature: 	Date: 6-21-95
Name: Samuel D. RABKIN	Signature: 	Date: 6/21/95
Name: Toshihiro MINETA	Signature: 	Date: 6/26/95
NAMES AND SIGNATURES OF WITNESSES		
Name:	Signature:	Date:
Name:	Signature:	Date:

Note: Prima facie evidence of execution may optionally be obtained by execution of this document before a U.S. Consul or before a local officer authorized to administer oaths whose authority is proved by a certificate from a U.S. Consul.